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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/784,383

02/23/2004

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0201-02528

8406

36192 7590 07/22/2010

AT&T Legal Department - CC

Attn: Patent Docketing

Room 2A-207

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EXAMINER

BLOUNT, ERIC

ART UNIT

PAPER NUMBER

2612

MAIL DATE

DELIVERY MODE

07/22/2010

PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDWARD MICHAEL SILVER and MARIA ADAMCZYK

Appeal 2009-005462
Application 10/784,383
Technology Center 2600

Before, ROBERT E. NAPPI, JOHN C. MARTIN, and
JOSEPH F. RUGGIERO, *Administrative Patent Judges*.

NAPPI, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

This is a decision on appeal under 35 U.S.C. § 134(a) of the final rejection of claims 1-17. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part, and we enter a new ground of rejection under 37 C.F.R. § 41.50(b).

INVENTION

The invention is directed to a method and system for identifying a particular location of interest. The system comprises a viewing apparatus that is used to select a location. The viewing apparatus transmits location information to a location identification device where the particular location of interest is determined. Identification information of the particular location is sent back to the viewing apparatus. *See Spec: 1-4.* Claim 1 is representative of the invention and reproduced below:

1. A method for identifying a location, comprising:
 - storing identification information associated with a delivery location, the identification including a street address and a telephone number for the delivery location;
 - providing a viewing apparatus that enables a user to have a view of his or her surroundings and to select a location from the view of the surroundings for identification;
 - causing the viewing apparatus to transmit location information regarding the location as selected by the user for the identification, the location information including an image of a target in the surroundings, the location information including coordinates defining the location of the user;
 - providing a location identification device operative to receive the location information, to use the location information to determine identification information for the location in response to at least the image of the target, and to transmit the identification information to the viewing apparatus; and
 - causing the viewing apparatus to display the identification information on the view of the surroundings, the identification

information including street address and telephone number for the delivery location to confirm that the image of the target is the delivery location.

REFERENCES

Hakala	US 6,452,544 B1	Sep. 17, 2002
Bide	US 6,470,264 B2	Oct. 22, 2002
Yokota	US 6,604,049 B2	Aug. 5, 2003

REJECTIONS AT ISSUE

Claims 1, 3, 6, and 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yokota. Ans. 3-5.

Claims 2, 4, 5, and 8-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yokota in view of Bide. Ans. 5-6.

Claims 12-17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yokota in view of Bide and Hakala. Ans. 7-8.

ISSUES

35 U.S.C. § 103(a) rejections

Claims 1, 3, 6, and 7

Appellants argue on pages 4-5 of the Appeal Brief that the Examiner's rejection of claims 1, 3, 6, and 7 is in error. Appellants select claim 1 as representative of the group comprising claims 1, 3, 6, and 7. App. Br. 5. Appellants argue that Yokota does not disclose confirming that the target

image is the delivery location by using identification information that includes the telephone number and street address. App. Br. 5.

Thus, Appellants' argument with respect to the Examiner's rejection of claims 1, 3, 6, and 7 present us with the issue: Did the Examiner err in finding that Yokota discloses displaying the identification on the view of the surroundings, the identification information including street address and telephone number for the delivery location to confirm that the image of the target is the delivery location?

Claims 2, 10, and 11

Appellants argue on page 6 of the Appeal Brief that the Examiner's rejection of claims 2, 10, and 11 is in error. Appellants select claim 2 as representative of the group comprising claims 2, 10, and 11. App. Br. 6. Appellants argue that Yokota in view of Bide does not disclose "orientation information regarding the location as selected by the user for identification." App. Br. 6.

Thus, Appellants' argument with respect to claims 2, 10, and 11 present us with the issue: Did the Examiner err in finding that Yokota in view of Bide discloses orientation information regarding the location as selected by the user for identification?

Claims 4-5, 8-9, and 12-15

Appellants argue on pages 6-7 of the Appeal Brief that the Examiner's rejection of claims 4-5, 8-9, and 12-15 is in error for the same reasons as indicated with claims 1 and 6. Thus, the issue before us is the same as discussed above with respect to claims 1 and 6.

Claims 16-17

Appellants argue on pages 7-8 of the Appeal Brief that the Examiner's rejection of claims 16-17 is in error. Appellants' select claim 16 as representative of the group comprising claims 16 and 17. App. Br. 7. Appellants argue that none of the references discloses "orientation of the location in the view." App. Br. 7.

Thus, Appellants' argument with respect to claims 16-17 presents us with the issue: Did the Examiner err in finding that Yokota in view of Bide and Hakala discloses determining the location and the orientation in the view to be within the specified distance from the user?

FINDINGS OF FACT (FF)

Yokota

1. Yokota discloses a client apparatus that can be in the form of eyeglasses, which contains a GPS receiver and a camera. The client apparatus sends image information and positional information to a server. The server matches the received image information with stored image information and sends information about the image to the user. Col. 7, ll. 14-33.
2. The apparatus contains a pointer device that can be used to select detailed information about a particular location. The detailed information includes text, audio, and Web information about the location. Col. 9, ll. 3-6, col. 10, ll. 56-65, and col. 11, ll. 47-65.
3. The pointing device contains a sensor that captures eye movements. This allows the user to fix on a particular area in the display and

nictitate (blink). By blinking the particular area is selected. Col. 7, l. 65 – col. 8, l. 3.

Bide

4. Bide discloses a device that contains a point direction detector (PDD), a user position detector (UPD), and a target position database (TPD). Col. 2, ll. 30-41.
5. The PDD detects the earth's magnetic and directional fields in order to determine a three dimensional direction vector of the device. Col. 2, ll. 61-66.
6. The UPD uses satellites to determine a user's current x, y, and z spatial co-ordinates. Col. 3, ll. 11-23.
7. The TPD provides a feature information record (FIR) for natural or man-made features. Col. 3, ll. 34-40.
8. The device has the ability to supply any publicly available information relating to a property including the postal address, name of the owner and/or occupier, their telephone number, the property value, function, history and architectural characteristics. Col. 6, ll. 22-26.

PRINCIPLES OF LAW

On the issue of obviousness, the Supreme Court has stated that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007).

Claims must “particularly point out and distinctly claim the subject matter which the applicant regards as his invention” 35 U.S.C. § 112, second paragraph. The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether those skilled in the art would understand what is

claimed when the claim is read in light of the specification. *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1575 (Fed. Cir. 1986). (citations omitted).

ANALYSIS

35 U.S.C. § 103(a) rejections

Claims 1, 3, 6, and 7

Appellants' contentions have not persuaded us of error in the Examiner's rejection of claim 1. Claim 1 recites "identification information including street address and telephone number for the delivery location." The Examiner finds Yokota discloses a system that provides several types of information for a particular location and that one of ordinary skill in the art would recognize that any type of information could be stored on the server. Ans. 4. Appellants' argue that this rationale is in error since the proper standard is not what one could do but rather what one would do. App. Br. 5. We agree with the Examiner.

On the issue of obviousness, the Supreme Court has stated that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007). It is proper to "take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *Id.* at 418. *See also id.* at 421 ("A person of ordinary skill is also a person of ordinary creativity, not an automaton."). In sum, the "suggestion test is in actuality quite flexible and not only permits, but requires, consideration of common knowledge and common sense." *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006).

Yokota discloses a system that provides image information about a user's surroundings. FF 1. The user may specifically select an object and request detailed information that includes text, audio, and Web information. FF 2. Skilled artisans would have understood that Yokota's detailed information can include any information pertinent to that particular building or location, such as a street address and telephone number for the building, hours of operation, and the floor level.

Moreover, the type of data recited constitutes non-functional descriptive material, as it does not alter how the method of claim 1 functions. Non-functional descriptive material cannot render patentable an otherwise unpatentable product or process. *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004); *Ex parte Nehls*, 88 USPQ2d 1883, 1887-90 (BPAI 2008) (Precedential). As such, we consider the limitations identifying the types of information as not differentiating the claim from the prior art. Thus, we sustain the Examiner's rejection of claim 1 and claims 3, 6, and 7 that have been grouped with claim 1.

Claims 2, 10, and 11

Appellants' contentions have not persuaded us of error in the Examiner's rejection of claim 2. Claim 2 recites "orientation information regarding the location as selected by the user for the identification." Appellants argue that neither Bide nor Yokota discloses this limitation since Bide only provides a directional heading that does not relate to a selected location. App. Br. 6. We disagree.

Yokota discloses a system that uses a sensor to detect a user's eye movement. FF 3. When a user fixes his/her eyes on a particular area and nictitates (blinks), that portion of the display area is selected. FF 3. Bide

discloses a system wherein a three dimensional direction vector is calculated along with x, y, and z spatial co-ordinates of a user's current location. FF 5, 6. This information is used to determine exactly where the user is located and is also used to present information regarding the location of natural or manmade features surrounding the user. FF 7. Combining Yokota's eye movement detection system with Bide's system that calculates three dimensional direction vectors and spatial co-ordinates is nothing more than using known elements to perform the function of determining orientation information. As such, we find that the combination of Yokota with Bide yields the predictable result of determining orientation information of a selected location. As such, Appellants' arguments are not found to be persuasive and we sustain the Examiner's rejection of claim 2 and claims 10-11 that are grouped with claim 2.

Claims 4-5, 8-9, and 12-15

Appellants' arguments have not persuaded us of error in the Examiner's rejection of claims 4-5, 8-9, and 12-15. Appellants' arguments that the rejection of these claims is in error for the reasons discussed with respect to claims 1 and 6 are not persuasive for the reasons discussed *supra* with respect to claims 1 and 6. Therefore, we sustain the Examiner's rejection of claims 4-5, 8-9, and 12-15.

Claims 16-17

For the reasons set forth subsequently in this opinion, with respect to claims 16-17, the existing prior art rejections must be reversed *pro forma* because they are necessarily based on speculative assumptions and inferences as to the meaning of the claims. *See In re Steele*, 305 F.2d 859, 862-863 (CCPA 1962). It should be understood, however, that our decision

in this regard is based solely on the indefiniteness of the claimed subject matter and does not reflect the adequacy or the inadequacy of the prior art evidence applied in support of the rejection before us. Once definite claims are presented, the Examiner is free to apply the same, different, or additional prior art if the Examiner so chooses.

New Rejection within 37 C.F.R. § 41.50(b)

Claims 16-17 are rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Claim 16 recites “determining the location and the orientation in the view to be within the specified distance from the user.” Claim 17 is dependent upon claim 16 and therefore incorporates the same limitation. Although we understand what it means to determine whether the “location” is within the specified distance of the user, it is unclear what it means to additionally determine that the “orientation” is within the specified distance of the user. Appellants’ Specification, the claims, and the arguments do not provide sufficient support to determine Appellants mean by this limitation. As such, claims 16-17 are rejected under 35 U.S.C. § 112, second paragraph as being indefinite.

CONCLUSION

The Examiner did not err in finding that Yokota discloses displaying the identification on the view of the surroundings, the identification information including street address and telephone number for the delivery location to confirm that the image of the target is the delivery location.

The Examiner did not err in finding that Yokota in view of Bide discloses orientation information regarding the location as selected by the user for identification.

SUMMARY

The Examiner's decision to reject claims 1-15 under 35 U.S.C. § 103(a) is affirmed.

We have *pro forma* reversed the Examiner's rejection of claims 16-17. We have instituted our own rejection of these claims on appeal under 35 U.S.C. § 112, second paragraph.

Regarding the affirmed rejection(s), 37 C.F.R. § 41.52(a)(1) provides "[a]ppellant may file a single request for rehearing within two months from the date of the original decision of the Board."

In addition to affirming the Examiner's rejection(s) of one or more claims, this decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should the Appellant elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the Appellant elects prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136 (a)(1)(v) (2010).

Appeal 2009-005462
Application 10/784,383

AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)

ELD

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